

REMARKS

Claims 65-78 and 97-118 are currently pending, of which claims 65, 97 and 108 are in independent form. Claims 65, 97 and 108 are amended by the present response. Support for the amendments may be found in the present patent application, for example, in respect of Paragraphs [0047]-[0048] of the published application, U.S. Patent Application No. 2001/0005861, *inter alia*. No new matter has been added.

Favorable reconsideration of the present patent application as currently constituted is respectfully requested.

Regarding the Provisional Double Patenting Rejections

In the pending Office Action, claims 65, 97 and 108 are rejected the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 90, 99 and 105 of co-pending U.S. Patent Application No. 09/782,107. Without acquiescing in the putative correspondence between the claim sets, Applicant has enclosed herewith an appropriate terminal disclaimer in accordance with 37 C.F.R. §1.321. It is therefore respectfully submitted that the pending double patenting rejection has been obviated hereby.

Regarding the Claim Rejections - 35 U.S.C. §103

In the pending Office Action, claims 65, 67-70, 89, 97, 99, 108 and 110 stand rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 5,958,006 to Eggleston et al. (hereinafter the *Eggleston* reference) in view of United States Patent No. 6,381,634 to Tello et al. (hereinafter the *Tello* reference).

Additionally, claims 71-73, 100-102 and 111-113 are rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of the *Eggleston* and *Tello* references in view of Official Notice that "word processing files, audio files, and video files were all old and well known types of email attachments at the time the invention was made, and that word processing type files could be processed (displayed) by mobile devices while video files could not, due to limitations on processing capabilities at the time."

Finally, claims 66, 74-78, 98, 103-107, 109 and 114-118 are rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of *Eggleston*, *Tello* and Official Notice in view of U.S. Patent No. 5,964,833 to Kikinis (hereinafter the *Kikinis* reference).

With regard to the rejection of base claim 65, the Examiner comments:

8. With regard to independent claim 65, Eggleston disclosed a method of redirecting e-mail messages and message attachments to a user of a mobile data communication device that is associated with a host system and communicates therewith, the user having a first e-mail address associated with the host system (users have email accounts)(col. 6, II. 59-61) the method comprising:

...

redirecting at least a portion of the e-mail message from the host system to the mobile data communication device via a wireless network (e.g. when the user has implemented a filter and only part of the message is sent to the user, *seen inter alia* Col 3, lines 23-26 and Col 10, lines 10-32);

...

receiving from the mobile data communication device a reply e-mail message (user replies to a message)(col. 3, II. 35-56); and

...

Eggleston fails to specifically disclose that the message is redirected to a second address associated with the user or that the reply message's originating address is configured to be the first address.

Tello discloses a similar system for forwarding e-mail messages from a host system associated with a first e-mail address to a second system associated with a second e-mail address. Tello teaches receiving an e-mail message at a host machine (ISP mail server) associated with a first e-mail address (well-known-name value 505)(col. 4, ll. 43-48; col. 5, ll. 29-33), and redirecting the message to a second address associated with the recipient (well-known-name-value is converted into literal address for redirection)(col. 5, ll. 33-39). Tello further discloses that the user's well-known name address remains unchanged, even if the literal address associated with it changes (col. 5, ll. 56-67), permitting e-mail address portability (col. 5, ll. 58-60). The combined teachings of Eggleston and Tello would have taught and/or suggested using the first address (the well-known name value) as the return address in any reply messages, since it would have maintained the portability of the address, permitting

later communications in response to the reply message to reach the user via the SOP system, even if the user's literal address changed in the meantime.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to permit forwarding of messages to a second address associated with the user, and use the first address as the originating address of any subsequent reply messages, to maintain portability of the user's e-mail address and ensure that additional messages in the conversation are sent to the user's current location.

Additionally, base claims 97 and 108 appear to be rejected based on the same reasoning.

Applicant respectfully submits that the pending rejections under §103(a) have been overcome or otherwise rendered moot by the present response. The claimed embodiments of the present disclosure are generally directed to a scheme for redirecting email messages and attachments between a messaging host system and a user's wireless mobile data communication device. As currently claimed, a data item, which includes a message and an attachment and which is addressed to the user's first address associated with the messaging host system, is received at the messaging host system from a sender. At least a portion of the message is repackaged with an outer envelope having a second address that is associated with the mobile data communication device and the repackaged portion is redirected over a wireless

network. Responsive to a request, i.e., a first command message, the attachment is redirected to the mobile data communication device. A reply e-mail message that is packaged in an outer envelope is received at the host system from the mobile data communication device. The reply e-mail message is removed from the envelope and sent to the sender with the first address configured as the reply e-mail message's originating address.

The Examiner admits that the *Eggleston* reference fails to disclose that the message is redirected to a second address or that the reply message's originating address is configured to be the first address, relying on *Tello* for this disclosure. Applicant respectfully submits that *Tello* is of no avail with regard to curing the deficiencies of *Eggleston*, as will be discussed in further detail hereinbelow. Additionally, Applicant submits that neither of the applied references discloses repackaging at least a portion of the e-mail message with an outer envelope having a second address associated with the mobile data communication. Finally, neither of the applied references discloses receiving a reply e-mail message that is packaged in an outer envelope from the mobile data communication device or removing the reply e-mail message from the outer envelope.

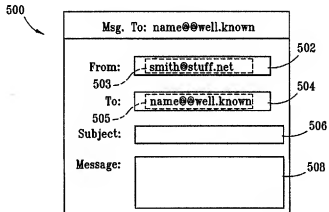
Tello does not teach or suggest a first address of the user that is associated with the host system.

Tello addresses the need for email addresses that can be retained by an Internet user, even when the user changes Internet Service Provider (ISP). Accordingly, Tello is directed to effectuating portability of email addresses between different ISPs. The presence of the portable email service is indicated in the messaging headers by either a specialized-address format or by a software tag. Col. 4, lines 48-51. For example, the specialized-address format is shown in FIG. 3, reproduced herein for convenience, wherein a well-known-name value 505 is inserted in field 504. The format of value 505 indicates that a translation service or a service control point (SCP) 200 must be accessed by the sender's

ISP by submitting a message having the message header with the well-known-name value 505. As illustrated in FIG. 3, the well-known-name value is "name@@wellknown",

wherein the "@@" characters are an indicator to alert the

FIG. 3



sender's ISP, i.e., ISP 100, that SCP 200 must be accessed before the message may be transmitted to the intended recipient. But it is clear from *Tello* that although "name@@wellknown" is associated with the user, this value is not the claimed first address that is associated with the host system. The value "name@@wellknown" is associated with SCP 200 and is an indicator to the ISP that SCP 200 must be accessed in order to acquire an email address (referred to in *Tello* as "literal address value"), e.g., "userx@commercial_isp.com", that is associated with the intended recipient's ISP (e.g., ISP 300) and used for actual routing of the email message. Thus, although the well-known-name value is entered in the "to" field 504 for a recipient, it is never used as an actual destination "email address" of the recipient. Nor is the well-known-name value is used in transmitting the message to the SCP, since the SCP's address is separately provided for transmitting only a portion of the message (i.e., the IP header information and the IP data field) from the sender's ISP (i.e., ISP 100). See destination IP address 624 (translation.scp) in FIG. 5.

Based on the foregoing, it is manifestly clear that the well-known-name value in *Tello* is merely an indicator to alert the sender's ISP that the portability email service is to be accessed for obtaining the actual email address of the intended

recipient. Applicant respectfully submits, accordingly, that it is a complete mischaracterization to equate the claimed mail item's first address that is associated with the messaging host system to the well-known-value of *Tello*. At a minimum, therefore, the teachings of *Tello* thoroughly fail to cure the acknowledged deficiency of the *Eggleston* reference.

There is no teaching or suggestion in *Eggleston*, *Tello* or any of the cited references with respect to packaging an e-mail message with an envelope having a second address that is associated with a mobile data communication device.

Eggleston is concerned with filtering incoming email for a user and forwarding email that meets the filters to a wireless user device. *Eggleston* does not appear to disclose or suggest that a mail item is repackaged with an outer envelope having a second address for transmission to a wireless user device.

Additionally, *Tello* is merely concerned with providing portability of ISP email addresses wherein a translation service is invoked in order to translate a well-known-name value to an actual email address of an intended recipient. Once the actual email address of the intended recipient (i.e., the literal address value) is obtained, it is used in transmitting the email

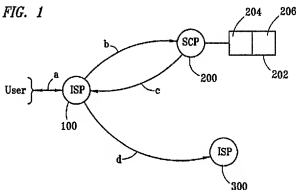
message using known standard communication methods, as discussed in the following passage from Tello at column 5, lines 28-42:

The user is provided e-mail portability service through implementation of the SCP 200 into the Internet. Referring back to FIG. 1, the first ISP 100 submits an address translation request to SCP 200 for the literal address value of "name@wellknown," as set out by communications path "b". SCP 200 translates the well-known name value into the corresponding literal address value "userx@commercial_isp.com" and returns this value to the first ISP 100 through communications path "c". The first ISP 100 then sends the e-mail message to this literal address using standard methods and communications protocols, as is known in the art. If there is not a corresponding literal address value or if there is an other error on the SCP 200, then an error message or a failure value is returned to the first ISP 100.

In other words, the sender's ISP 100 merely sends the email message to a literal address value of the intended recipient using path "d" (see FIG. 1, reproduced herein for convenience) using the standard techniques once the literal address values has

been returned from SCP 200.

FIG. 1



Thus, it should be clear that there is no packaging of the email message in Tello into an envelope having a second address. Once the literal address

value is determined for a particular email message, the well-known-name value is no longer needed, and the literal address value is used in the "to" field to effectuate the transmission in a conventional manner.

Further, none of the additional references not specifically mentioned here appear to disclose or suggest the newly added claim features regarding repackaging a mail item with an outer envelope having a second address for transmission to the mobile data communication device.

There is no teaching or suggestion in *Eggleston*, *Tello* or the other references relied on with respect to receiving a reply mail item that is packaged in an outer envelope from a mobile data communication device and removing the outer envelope.

As noted above, *Eggleston* is concerned with filtering email for a user and forwarding those emails that pass the filters to a wireless user device. *Eggleston* does not disclose or suggest that a reply mail item is received that is packaged with an outer envelope. Neither does *Eggleston* appear to disclose or suggest that the reply mail item is removed from the outer envelope for forwarding to the sender.

As should be readily recognized, the entire disclosure of *Tello* is simply concerned with the forward path of an email

recipient (associated with ISP 300). There appears to be no discussion whatsoever with respect to the transmission of an email message in the opposite direction. Accordingly, the claimed features relative to receiving a reply mail item that is packaged in an outer envelope from a mobile data communication device and removing the outer envelope are simply neither taught nor suggested in *Tello*.

At least based on the foregoing analysis, Applicant respectfully submits that base claims 65, 97 and 108 and dependent claims 67-70, 99 and 110 are allowable over the applied art.

Two additional references are combined with *Eggleston* and *Tello* against the remaining dependent claims. The Official Notice does not cure the deficiency of *Eggleston*, being directed solely to file types and their displays. *Kikinis* also does not provide any teaching with regard to the claimed embodiments of the base claims and does not cure the deficiencies of *Eggleston*. Accordingly, claims 66, 71-78, 98, 100-107, 109 and 111-118 are also believed to be allowable over the applied art.

Reservation of Rights

Notwithstanding the foregoing, Applicant reserves all rights not exercised in connection with this response, such as, e.g., the right to challenge or rebut any tacit or explicit characterization of any reference or of the present claims, the right to challenge any Official Notice(s) taken, the right to challenge or rebut any asserted factual or legal basis of any of the rejections of the present Office Action, or the right to swear behind any cited reference such as provided under 37 C.F.R. §1.131 or otherwise.

Fee Statement

Applicant is filing herewith a Request for Continued Examination (RCE) of the instant patent application, a Terminal Disclaimer and a Petition for a Two-Month Extension of Time. Accordingly, payment via electronic filing is being authorized in the applicable amount. Applicant believes no additional fees are due for the filing of this Submission. If any additional fees are due or any overpayments have been made, however, please charge or credit our deposit account (Deposit Account No. 03-1130).

SUMMARY AND CONCLUSION

In view of the fact that none of the art of the record, whether considered alone or in combination discloses, anticipates or suggests the present embodiments, as now defined by the independent claims, and in further view of the above amendments and/or remarks, reconsideration of the Action and allowance of the present patent application are respectfully requested and are believed to be appropriate.

Dated this 16th day of February, 2009.

Respectfully submitted,

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